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EXAMINER	
AUGHENBAUGH, WALTER	

ART UNIT	PAPER NUMBER
1794	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/615,681	LAI ET AL.	
	Examiner	Art Unit	
	Walter B. Aughenbaugh	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09 August 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 3-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 3-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08 July 2003 and 09 August 2007* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/16/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgement of Applicant's Amendments

1. Applicant's amendments in claims 1 and 11 in the Amendment filed August 9, 2007 (Amdt. A) have been received and considered by Examiner.

2. Applicant's cancellation of claim 2 in Amdt. A is acknowledged by Examiner.

3. Applicant's amendments in the specification in Amdt. A (paragraphs 55 and 58) have been received and considered by Examiner.

4. Applicant's Replacement Figures filed with Amdt. A have been received and considered by Examiner.

Information Disclosure Statement

5. The information disclosure statement filed October 16, 2003 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein regarding the first four entries under the "OTHER DOCUMENTS" heading on pages 1 and 2 of the PTO-1449 form has not been considered. A copy of each of the documents listed under "OTHER DOCUMENTS" on each of pages 1 and 2 of the PTO-1449 that are described as "Collection[s] of Documents..." could not be located in the IFW file. Applicant was notified of this deficiency in paragraph 2 of the previous Office Action mailed February 9, 2007 (Applicant has submitted copies of the documents listed on pages 3 and 4 of the PTO-1449 form [but not those listed on pages 1 and 2], so the entries on pages 3 and 4 of the PTO-1449 form have been initialed by the Examiner).

WITHDRAWN OBJECTIONS

6. The objections to the drawings made of record in paragraphs 3 and 4 of the previous Office Action mailed February 9, 2007 have been withdrawn due to Applicant's filing of Replacement Figures with Amdt. A.

WITHDRAWN REJECTIONS

7. The 35 U.S.C. 112 rejection of claim 2 made of record in paragraph 8 of the previous Office Action mailed February 9, 2007 has been withdrawn due to Applicant's cancellation of claim 2 in Amdt. A.

8. The 35 U.S.C. 103 rejections of claims 11-17 made of record in paragraphs 10 and 12 of the previous Office Action mailed February 9, 2007 have been withdrawn due to Applicant's amendment in claim 11 in Amdt. A.

9. The 35 U.S.C. 103 rejection of claim 2 made of record in paragraph 13 of the previous Office Action mailed February 9, 2007 has been withdrawn due to Applicant's cancellation of claim 2 in Amdt. A.

REPEATED OBJECTION

Drawings

10. The objection to Fig. 7 and Fig. 8 made of record in paragraph 5 of the previous Office Action mailed February 9, 2007 has been repeated for the reasons previously made of record. While Applicant has amended paragraphs 55 and 58, paragraphs 30 and 33 have not been amended. See paragraph 5 of the previous Office Action mailed February 9, 2007 (which explicitly refers to paragraphs 30 and 33).

REPEATED REJECTIONS

Claim Rejections - 35 USC § 103

11. The 35 U.S.C. 103 rejection of claims 1 and 3-10 made of record in paragraphs 11 and 14 of the previous Office Action mailed February 9, 2007 have been repeated for the reasons previously made of record.

NEW OBJECTIONS

Drawings

12. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 106 and 108 (regarding Fig. 1 and 4: see paragraphs 25 and 28 of specification). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

13. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Applicant inserted "(Fig. 4)" in the first sentence of paragraph 58 in Amdt. A, but the first sentence of paragraph 58 discusses reference character 122, yet this reference character does not appear in Fig. 4. A

reading of the first sentence of paragraph 58 as amended in Amdt. A indicates that reference character 122 is in Fig. 4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

14. Claims 11-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 5,932,336) in view of Briant et al. (USPN 6,748,677) and in further view of McKay et al. (USPN 5,869,591).

In regard to claim 11, Allen et al. teach an article of footwear (shoe, item 10, Fig. 1, 2 and 6) comprising an upper, item 12, and a sole, item 14, wherein the sole has an outsole for directly contacting a ground surface (outsole, item 60, Fig. 6) (col. 5, lines 39-41 and col. 6, lines 64-67). Allen et al. teach that the article of footwear comprises at least one element (frame, item 50) (col. 6, lines 22-45, Fig. 4-6). Allen et al. teach that the article of footwear comprises at least one cleat receptacle (spike sockets/receptacles, item 54) (frame, item 50) (col. 6, lines 22-29, col. 7, lines 44-52 and Fig. 6). Allen et al. teach that the outsole, item 60, comprises a material (which corresponds to Applicant's claimed "second material of the outsole") that is less hard than the at

least one element (frame, item 50) because Allen et al. that the material of the frame, item 50, is harder than the material of the outsole, item 60 (col. 6, lines 29-38 and col. 6, line 64-col. 7, line 13). The material of the outsole, item 60, of Allen et al. is less dense than the at least one element (frame, item 50) because the material of the outsole, item 60, of Allen et al. is softer than the material of the frame, item 50 (col. 6, lines 29-38 and col. 6, line 64-col. 7, line 13), and therefore serves as a cushioning material (col. 7, lines 14-17) and provides more of a cushioning effect than frame, item 50, provides in the combination of the frame and outsole (col. 7, lines 14-17), so the density of the outsole, item 60, is necessarily less than that of the frame, item 50, since the cushioning outsole is more easily compressed (there are necessarily spaces, that are either visible to the naked eye or not, that exist in the cushioning material which allow the cushioning material to compress when a sufficient force is applied to the cushioning material, which render the cushioning material less dense that the material of the frame, which is not a cushioning material). The material of the outsole, item 60, is compatible for compression molding with the at least one element (frame, item 50) because the outsole and the frame coexist in the same final product (Fig. 4-6). The cleat receptacles (spike sockets/receptacles, item 54) are accessible for attachment of a non-metal cleat (col. 9, lines 9-22 and Fig. 6). The recitation "compression molded with the outsole" (line 4) is a method limitation that has not been given patentable weight since the method of forming the article is not germane to the issue of patentability of the article itself. The recitation "compression molded with" (line 4) does not recite any structural or compositional limitations of the claimed final product or of any components of the claimed final product. Allen et al. teach that the frame is preferably comprised

of a polyurethane or thermoplastic polyurethane (col. 6, lines 29-32) and that the frame is comprised of spike (cleat) receptacles (col. 6, lines 23-29).

Allen et al. fail to teach that the frame is formed from a material comprising at least 45% ethylene vinyl acetate, approximately 30% polyene elastomer and approximately 20% synthetic rubber.

Briant et al., however, disclose a detachable cleat system that is manufactured from any suitable polymeric material or combination of polymeric materials, either with or without reinforcement (col. 8, lines 12-16), where suitable polymeric materials include polyurethanes such as thermoplastic polyurethanes, ethylene vinyl acetate and polyethylenes (col. 8, lines 16-24).

McKay et al., furthermore, disclose a composition in the form of shoe soles (and therefore for use as a material in shoes), athletic sponge pads and heat insulation (col. 54, lines 32-34) that comprises olefin polymers including α-olefin homopolymers or interpolymers, ethylenes, propylenes, ethylene-propylene interpolymers, ethylene vinyl acetate, block elastomers and combinations thereof (col. 20, line 58-col. 21, line 6 and col. 3, line 43-col. 4, line 26), where the interpolymers preferably comprise comonomers such as 1-butane, 4-methyl-1-pentene, 1-hexene, 1-octene or C_4-C_{20} dienes (polymerization of any of these comonomers results in a polyene) (col. 18, line 54-col. 19, line 30, in particular, col. 18, lines 54-60 and col. 19, lines 14-30).

Therefore, one of ordinary skill in the art would have recognized to have replaced the thermoplastic polyurethane of the frame of Allen et al. with a composition comprising ethylene vinyl acetate since ethylene vinyl acetate and thermoplastic polyurethane are both suitable

materials for use in the formation of a detachable cleat system for athletic shoes as taught by Briant et al. and to have used the composition comprising a combination of ethylene vinyl acetate, polyene interpolymer and block elastomer of McKay et al. as the composition of the frame of Allen et al. since a composition formed from a combination of ethylene vinyl acetate, polyene interpolymer and block elastomer is a well known composition for use in formation of athletic shoes as taught by McKay et al.

In regard to the claimed relative amounts of ethylene vinyl acetate, polyene elastomer and synthetic rubber, the claimed relative amounts fall within the teaching of McKay et al. of "any combination thereof" at col. 20, line 65 (col. 20, lines 58-65). Furthermore, "[g]enerally, differences in concentration or temperature will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical." MPEP 2144.05 II.A.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have replaced the thermoplastic polyurethane of the frame of Allen et al. with a composition comprising ethylene vinyl acetate since ethylene vinyl acetate and thermoplastic polyurethane are both suitable materials for use in the formation of a detachable cleat system for athletic shoes as taught by Briant et al. and to have used the composition comprising a combination of ethylene vinyl acetate, polyene interpolymer and block elastomer of McKay et al. in the claimed relative amounts as the composition of the frame of Allen et al. since a composition formed from a combination of ethylene vinyl acetate, polyene interpolymer and block elastomer is a well known composition for use in formation of athletic shoes as taught by McKay et al.

In regard to claim 12, Allen et al. teach that the second material of outsole, item 60, comprises thermoplastic polyurethane or a thermoplastic polyurethane/thermoplastic rubber blend (which is a rubber and a thermoplastic polyurethane) (col. 6, line 66-col. 7, line 3).

In regard to claim 13, Allen et al. teach that the second material of outsole, item 60, comprises a thermoplastic polyurethane/thermoplastic rubber blend and therefore both a rubber and a thermoplastic polyurethane (col. 6, line 66-col. 7, line 3).

In regard to claims 14 and 15, the at least one element (frame, item 50) of Allen et al. comprises a plurality of elements (the portion of frame, item 50, that corresponds to sections 30, 32 and 34 in Fig. 2 and the section consisting of two spikes, 40d and 40g, in section 32 in Fig. 2: comparison of the location of frame 50 in Fig. 6 with Fig. 2 makes it clear that spikes 40a-q sit on top of frame 50, col. 5, line 63-col. 6, line 4 and col. 6, line 11-22), and both of these elements of the plurality of elements includes a cleat receptacle, item 54 (Fig. 2 and 6).

15. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Allen et al. (USPN 5,932,336) in view of Briant et al. (USPN 6,748,677) and in further view of McKay et al. (USPN 5,869,591) and in further view of Safdie (USPN 5,771,605).

Allen et al., Briant et al. and McKay et al. teach the article of footwear as discussed above in regard to claim 11.

Allen et al., Briant et al. and McKay et al. fail to teach that the at least one element (frame, item 50) of Allen et al. includes a foil layer that is visible on the sole as claimed in claim 16, or that the at least one element (frame, item 50) of Allen et al. includes an electroplated member that is visible on the sole as claimed in claim 17.

Safdie, however, in regard to claim 16, discloses an image-display system for apparel such as shoes (col. 1, lines 11-25) that displays such images as foil images (col. 2, lines 47-56). Safdie discloses that the display panel, item 32, is attached to a metal plate, item 22, (col. 5, lines 7-9 and Fig. 1 and 12) which may also be considered to be a foil since Safdie teaches that it is cut from a sheet of metal (col. 5, lines 36-42). Therefore, one of ordinary skill in the art would have recognized to have included an image-display system that comprises a foil layer of Safdie that is suitably sized on an exposed (visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises a foil layer such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image (for example, a label) as taught by Safdie.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an image-display system that comprises a foil layer of Safdie that is suitably sized on an exposed (visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises a foil layer such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image as taught by Safdie.

Safdie, however, in regard to claim 17, discloses an image-display system for apparel such as shoes (col. 1, lines 11-25) that displays such images as foil images (col. 2, lines 47-56). Safdie discloses that the display panel, item 32, is attached to a metal plate, item 22, (col. 5, lines 7-9 and Fig. 1 and 12), where the plate 22 is made of, or coated with, an electroplated metal (col. 5, lines 53-59). Therefore, one of ordinary skill in the art would have recognized to have included an image-display system that comprises an electroplated member of Safdie that is

suitably sized on an exposed (visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises an electroplated member such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image (for example, a label) as taught by Safdie.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an image-display system that comprises an electroplated member of Safdie that is suitably sized on an exposed (visible) portion of the at least one element (frame, item 50) since it is well known to apply an image-display system that comprises an electroplated member such as that of Safdie on a shoe in order to display an image that is desired to be displayed for the particular desired end use of the image as taught by Safdie.

Response to Arguments

16. Applicant's arguments presented on pages 10-12 of Amdt. A regarding the 35 U.S.C. 103 rejections of claims 1 and 3-15 have been fully considered but are not persuasive.

Applicant argues that Allen does not disclose the use of "any material comprising ethylene vinyl acetate", but the Office Action does not state that Allen does disclose "any material comprising ethylene vinyl acetate".

Applicant argues that Briant "teaches that the flexible walls of the receptacle have the *same* properties as the outsole", but Applicant has not provided any evidence that supports this contention: Applicant suggests that the teaching of Briant that the flexible wall "is an integral part of the sole" requires that "the flexible walls of the receptacle have the *same* properties as the outsole", but this conclusion does not follow from the teaching of Briant that the flexible wall "is an integral part of the sole" (two or more components, each of which comprise a different

material, can be combined to form an integral composite item [such as a multi-component sole, as taught by Briant in the portion of Briant cited by Applicant]).

The preferred embodiment of Briant mentioned by Applicant is only one embodiment and does not serve to limit the scope of the invention of Briant to only the preferred embodiment. Applicant argues that Briant teaches away from Applicant's invention because of the preferred embodiment of Briant mentioned by Applicant, but Briant does not teach away from Applicant's invention because the preferred embodiment of Briant mentioned by Applicant is only one embodiment and does not serve to limit the scope of the invention of Briant to only the preferred embodiment. Briant states that "it is not required" that the sole be made by injection molding from a single piece of plastic material (col. 6, lines 27-31).

Applicant's reference to "the components of the walls of the receptacle in claim 1" on page 11 of Amdt. A does not appear to be relevant to the prosecution of this application because Applicant's claim 1 does not recite a "receptacle", nor does it recite "components" or "walls".

17. Applicant's arguments presented on pages 12-13 of Amdt. A regarding the 35 U.S.C. 103 rejections of the remainder of the claims have been fully considered but are not persuasive.

Applicant's arguments depend entirely upon Applicant's arguments presented on pages 10-12 of Amdt. A regarding the 35 U.S.C. 103 rejections of claims 1 and 3-15, which have been addressed above.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is (571) 272-1488. While the examiner sets his work schedule under the Increased Flexitime Policy, he can normally be reached on Monday-Friday from 8:45am to 5:15pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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